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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,782	12/09/2003	James E. Christensen	YOR920030601US1 (17237)	4825
7590 01/04/2007 STEVEN FISCHMAN, ESQ. SCULLY, SCOTT, MURPHY AND PRESSER 400 Garden City Plaza Garden City, NY 11530			EXAMINER TRAN, PHILIP B	
			ART UNIT 2155	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			01/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/730,782	<b>Applicant(s)</b> CHRISTENSEN ET AL.	
	<b>Examiner</b> Philip B. Tran	<b>Art Unit</b> 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/9/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 U.S.C. § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4 and 6-9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Dodrill et al (Hereafter, Dodrill), U.S. Pat. No. 6,807,565.

Regarding claim 1, Dodrill teaches a method for establishing a private message chat between electronic devices (= instant messaging using voice enabled web) [see Abstract], the method comprising the steps of:

providing an indication as to the availability of a user for receiving a private message chat (= determining whether a receiving party is available to receive the voice message) [see Abstract and Col. 9, Lines 15-30];

receiving an audio input message from at least one first client and transmitting said audio input message to at least one second client, wherein said at least one second client can receive and play back said audio input message via said private message chat (= playing the voice message for the receiving party) [see Col. 3, Lines 34-46 and Col. 9, Lines 15-30].

Regarding claim 2, Dodrill further teaches the method as claimed in claim 1, further comprising the step of receiving, at said first client, a reply audio input message from said at least one second client (= speaking with the sending party via voice over IP) [see Col. 8, Lines 13-53].

Regarding claim 3, Dodrill further teaches the method as claimed in claim 1, further comprising the step of receiving, at said first client, a reply text input message from said at least one second client (= creating instant message) [see Col. 8, Lines 13-53].

Regarding claim 4, Dodrill further teaches the method as claimed in claim 1, wherein said step of transmitting said audio input message includes voice over Internet Protocol transmitting (= voice over IP) [see Col. 8, Lines 13-53].

Claim 6 is rejected under the same rationale set forth above to claim 1.

Claim 7 is rejected under the same rationale set forth above to claim 1.

Regarding claim 8, Dodrill further teaches the system for providing voice-based communications as claimed in claim 7, wherein said means for storing said audio input message resides in said host server means [see Fig. 3 and Col. 8, Lines 13-53 and Col. 9, Lines 15-30].

Claim 9 is rejected under the same rationale set forth above to claim 4.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 10-12 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodrill et al (Hereafter, Dodrill), U.S. Pat. No. 6,807,565 in view of Lee, U.S. Pat. No. 7,111,044.

Regarding claim 5, Dodrill does not explicitly teach the method as claimed in claim 1, wherein said step of transmitting said audio input message includes transmitting via SIP. However, Lee, in the same field of voice chat establishing communication endeavor, discloses establishing a call between a sender and a target user using a common protocol such as Session Initiation Protocol (SIP) [see Lee, Col. 16, Line 61 to Col. 17, Line 21]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of Lee into the teaching of Dodrill in order to establish sessions for features such as audio/video conferencing and call forwarding to be deployed over IP networks. Thus, enabling service providers to integrate basic IP telephony services with Web, e-mail, and chat services and supporting traditional telephony features such as personal mobility, time-

of-day routing and call forwarding based on the geographical location of the person being called.

Claim 10 is rejected under the same rationale set forth above to claim 5.

Regarding claim 11, Dodrill teaches a system for voice chat comprising:

a first client device comprising:

a means for receiving an audio message input from a user of said first client device and a means for transmitting said audio message in response to said means for selecting said second client device (= recording and sending a voice message by the sending party) [see Abstract and Col. 8, Lines 13-53 and Col. 9, Lines 15-30]; and,

said second client device comprising:

a means for receiving said transmitted audio message and storing said audio message, a means for providing an indicator that said audio message has been received from said first client device and a means for playing said audio message (= playing the voice message for the receiving party) [see Col. 3, Lines 34-46 and Col. 9, Lines 15-30].

Dodrill further teaches determining whether a receiving party is available to receive the voice message [see Dodrill, Abstract and Col. 9, Lines 15-30]. However, Dodrill does not explicitly teach a means for receiving indication of the availability context of a second client device via a chat interface and a means for selecting said

second client device via said chat interface and a means for indicating availability context to said first client device.

Lee, in the same field of voice chat establishing communication endeavor, discloses presence status indicators 904 & 911 referred to as availability in such contexts indicates that a user is able or unable to receive messages via a chat interface [see Lee, Figs. 7 & 9 and Col. 22, Line 40 to Col. 23, Line 11]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of Lee into the teaching of Dodrill in order to efficiently and quickly identify the status of users so that the contexts can be provided.

Regarding claim 12, Dodrill further teaches the system for voice chat as claimed in claim 11, further comprising a host computer device including a means for determining availability status of said second chat client device for receiving a private message chat and providing an indication to a first client device as to the availability of said second chat client device to receive an audio input message, a means for receiving an audio message input from said first client device and transmitting said audio input message to said second chat client device (= determining whether a receiving party is available to receive the voice message) [see Abstract and Col. 9, Lines 15-30].

Claim 21 is rejected under the same rationale set forth above to claim 11.

Claim 22 is rejected under the same rationale set forth above to claim 12.

Claim 23 is rejected under the same rationale set forth above to claim 11.

5. Claims 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodrill et al (Hereafter, Dodrill), U.S. Pat. No. 6,807,565 in view of Lee, U.S. Pat. No. 7,111,044 and further in view of Kato, U.S. Pat. No. 7,039,675.

Regarding claim 13, Dodrill and Lee do not explicitly teach the system for voice chat as claimed in claim 11, wherein said first and second client device further comprises voice recognition means for transcribing received audio messages into textual information and integrating said textual information received from said first client device in a message chat session between users of said first and second devices. However, Kato, in the same field of voice chat endeavor, discloses a voice recognition unit as known in the art to subject the input audio data to recognition processing and convert the obtained results to text data [see Kato, Col. 7, Lines 37-63]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of Kato into the teaching of Dodrill and Lee in order to efficiently transcribe the received audio messages into textual information for displaying on the client's screen at a convenient time.

Regarding claim 14, Dodrill does not explicitly teach the system for voice chat as claimed in claim 13, wherein said second client device further comprises an interface means for enabling user selection of an icon for rendering said received audio message. However, Lee, in the same field of voice chat establishing communication endeavor, discloses presence status indicators 904 & 911 referred to as availability in



such contexts indicates that a user is able or unable to receive messages via a chat interface [see Lee, Figs. 7 & 9 and Col. 22, Line 40 to Col. 23, Line 11]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of Lee into the teaching of Dodrill in order to efficiently and quickly identify the status of users so that the contexts can be provided.

Regarding claim 15, Dodrill further teaches the system for voice chat as claimed in claim 14, wherein said second client device further comprises means for selecting a textual response mode and enabling text reply in response to received audio message (= creating instant message) [see Col. 8, Lines 13-53].

Regarding claim 16, Dodrill further teaches the system for voice chat as claimed in claim 14, wherein said second client device further comprises means for selecting an audio response mode and enabling an audio reply in response to received audio message (= speaking with the sending party via voice over IP) [see Col. 8, Lines 13-53].

Regarding claim 17, Dodrill further teaches the system for voice chat as claimed in claim 14, wherein either said first and second client device is enabled to select either an audio reply enabling audio reply or a text response mode enabling textual message reply from a single client device in a single chat session, whereby voice and text communications may be interleaved in a single chat session (= creating instant message or speaking with the sending party via voice over IP) [see Col. 8, Lines 13-53].

Regarding claim 18, Dodrill further teaches the system for voice chat as claimed in claim 14, further including means for generating biometric information associated with a user of said first client device, wherein said means for transmitting said audio, responsive to said means for selecting said second client device, further includes transmission of biometric information [see Col. 7, Line 66 to Col. 8, Line 13].

Regarding claim 19, Dodrill further teaches the system for voice chat as claimed in claim 14, wherein a first or second client device includes one or more devices, a first of said one or more devices enabling only audio communication and a second of said one or more devices enabling textual communication [see Col. 8, Lines 13-53].

Regarding claim 20, Dodrill further teaches the system for voice chat as claimed in claim 19, wherein a first or second client device comprises one or more of a personal computer, a PDA, and a cell phone device [see Fig. 1].

***Other References Cited***

6. The following references cited by the examiner but not relied upon are considered pertinent to applicant's disclosure.

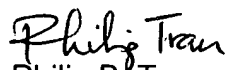
- A) Gudjonsson et al, U.S. Pat. No. 6,564,261.
- B) Burg, U.S. Pat. No. 7,039,040.
- C) Forsyth, U.S. Pat. No. 7,047,030.

- D) DeSimone, U.S. Pat. No. 6,175,619.
- E) Lukacs, U.S. Pat. No. 5,737,011.
- F) Martin, U.S. Pat. No. 6,931,114.
- G) Jackson et al, U.S. Pat. No. 6,721,703.
- H) Gold et al, U.S. Pat. Application Pub. No. US 2005/0102358 A1.
- I) Blattner et al, U.S. Pat. Application Pub. No. US 2004/0221224 A1.
- J) Zhao et al, U.S. Pat. Application Pub. No. US 2005/0128997 A1.

7. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED (35 U.S.C. § 133). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CAR 1.136(A).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (571) 273-8300. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Philip B. Tran  
Primary Examiner  
Art Unit 2155  
December 26, 2006